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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,518	10/19/2001	Tsuyoshi Sakata	34093	5439

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EXAMINER

VAN BRAMER, JOHN W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/980,518	<b>Applicant(s)</b> SAKATA, TSUYOSHI	
	<b>Examiner</b> John Van Bramer	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☒ Claim(s) 17,25-28,30-42 and 50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>101901 122004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d), a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because
  - a. The abstract has not been written as a single paragraph.
  - b. Legal phraseology such as "means" and "said" are used repeatedly.  
Correction is required.
  - c. The abstract does not clearly and concisely describe the invention as presented in the specification. For example, the applicant uses the term "pointer sending means" to refer to an RFID that is

attached to an advertisement or other media. The application also indicates "The user can easily access a network by using the pointer sending means as an entrance". This phrase is ambiguous and can easily be misinterpreted. One might understand this to mean that access to the network is provided by the "pointer sending means". However, based upon the specification, the pointer sending means provides a URL to the "portable terminal" and the "portable terminal" is then responsible for connecting to the network.

See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:
  - a. The applicant has not made reference to the claimed priority document in the first paragraph of the specification.
  - b. All patent applicants should use the metric (S.I.) units followed by the equivalent English units when describing their inventions in the specifications of patent applications.

Appropriate correction is required.

5. The examiner requests an English translation of the nonessential material, Japanese patent No. 65494/1999 referenced in the specification as per 37 CFR 1.57(f).

***Claim Objections***

6. Claims 18-28, 30-42 and 50 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 18-28, 30-42, and 50 have not been further treated on the merits.
7. Claims 44-49 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 44-49 do not pass the infringement test (Reference MPEP 608.01(n)(II and III)), since a printed advertisement or magazine need not be an article.
8. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The applicant is claiming an information collection system in claim 16. The system includes a "pointer sending means" with a memory for storing historic data in relation to customers requesting the pointer. The "pointer sending means" is affixed to an advertisement. The placement or posting of the advertisement in a train does not provide a further limiting factor with regard to the information collection system.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A sensor or other method for obtaining weather information is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).
11. Claims 13 and 14 refer to the gathering of temperature, humidity, and weather information. Based upon the specification, this information is gathered with the use of "the sensor" (page 28, lines 5-9). This is the first and only time a sensor is mentioned throughout the specification. The drawings and claims also fail to disclose a sensor. With no mechanism for acquiring temperature, humidity, and weather information claims 13 and 14 are not enabled.
12. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant has not disclosed a mechanism by which the portable terminal would obtain congestion information.

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13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

16. The claims are also replete with errors of insufficient antecedent basis.

Following is a sample of such errors:

- a. Claim 1 recites the limitation "information provision means" in line 7 and "the pointer" in line 3. There is insufficient antecedent basis for this limitation in the claim.
- b. Claim 2 recites the limitation "the information provider" in lines 11 and 12. There is insufficient antecedent basis for this limitation in the claim.
- c. Claim 5 recites the limitation "said advertisement medium" in line 23. Since, and advertisement medium is not disclosed in claim 1, and the claim is dependent on any one of claims 1 through 3, there is insufficient antecedent basis for this limitation in the claim.

- d. Claim 6 recites the limitation "said pointer sending means information" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim.
- e. Claim 9 recites the limitation "the pointer sending count" in line 15. There is insufficient antecedent basis for this limitation in the claim.
- f. Claim 11 recites the limitation "the time information" in line 23. There is insufficient antecedent basis for this limitation in the claim.
- g. Claim 12 recites the limitation "the day of the week or day of the month information" in line 1. There is insufficient antecedent basis for this limitation in the claim.
- h. Claim 13 recites the limitation "the temperature of humidity information" in line 5. There is insufficient antecedent basis for this limitation in the claim.
- i. Claim 14 recites the limitation "the weather information" in line 9. There is insufficient antecedent basis for this limitation in the claim.
- j. Claim 15 recites the limitation "the congestion information" in line 13. There is insufficient antecedent basis for this limitation in the claim.
- k. Claim 16 recites the limitation "the transmission count" in line 17. There is insufficient antecedent basis for this limitation in the claim.



***Claim Rejections - 35 USC § 101***

17. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

18. Claims 43-49 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. In claim 43 the applicant discloses an article on which an IC card has been affixed. The IC card stores information regarding the network address of further data regarding the article is found. However, the IC card, as disclosed in the specification, is not capable of accessing a network. According to the specification a portable terminal is required to access the network. Therefore the IC card is not capable of recording "a pointer specifying the information acquisition destination" based upon "information acquired from a network". Claims 44-49 suffer from the same deficiencies. The applicant is advised that an "article", "advertisement", or "magazine" affixed with the IC card, as described in the specification, has no self-sustaining power source and thus is incapable of initiating the saving of any type of information. The IC card, as described in the specification, contains an antenna that receives power from some external device that is brought within a specified proximity of the article.
19. Claims 44-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 44-48 disclose non-functional descriptive material. A "printed advertisement" and a "magazine" constitute data per se (See MPEP 2106(IV)(B)(1)(b)).

***Claim Rejections - 35 USC § 102***

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1-12, 16, 29, and 43-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Durst et al (WO 98/51036).

Claim 1: Durst discloses an information collection system for acquiring information from a network comprising

- a. Pointer sending means for sending the pointer to information to be acquired from a network based on a request. (Page 4, line 22 through Page 5, line 24)
- b. A portable terminal having access means to a network, characterized in that said portable terminal acquires information from information provision means by using the pointer obtained after making a request of the pointer sending means. (Page 4, line 22 through Page 5, line 24)

Claim 2: Durst discloses an information collection system according to claim 1, characterized in that said portable terminal has access means to a network and acquires information from the information provider via a network. (Page 4, line 22 through Page 5, line 24)

Claim 3: Durst discloses an information collection system according to claim 2, characterized in that said pointer sending means is affixed to an advertisement medium and that said portable terminal uses said pointer obtained from said pointer sending means to acquire advertisement information from an advertisement server. (Page 4, line 22 through Page 5, line 24)

Claim 4: Durst discloses an information collection system according to claim 3, characterized in that said advertisement medium is a printed advertisement medium. (Page 4, line 22 through Page 5, line 24)

Claim 5: Durst discloses an information collection system according to any one of the claims 1 through 3, characterized in that said advertisement medium displays a varying advertisement and that said pointer sending means sends a pointer corresponding to the contents of the varying advertisement based on a request. (Page 19, line 22 through Page 20, line 31)

Claim 6: Durst discloses an information collection system according to any one of the claims 1 through 3, characterized in that information indicating the access status of said portable terminal to said pointer sending means information indicating the status assumed when said portable terminal accessed said pointer sending means, and information provided by said portable terminal that accessed said

pointer sending means is stored as history information. (Page 17, line 10 through Page 19, line 2)

Claim 7: Durst discloses an information collection system according to claim 6, characterized in that said history information is saved by said pointer sending means. (Page 17, line 10 through Page 19, line 2)

Claim 8: Durst discloses an information collection system according to claim 6, characterized in that said history information is saved in elsewhere than said pointer sending means. (Page 15, line 19 through Page 16, line 6)

Claim 9: Durst discloses an information collection system according to claim 6, characterized in that the pointer sending count of said pointer sending means is saved as said history information. (Page 26, line 11 through Page 27, line 31)

Claim 10: Durst discloses an information collection system according to claim 6, characterized in that said portable terminal sends personal information when accessing said pointer sending means and that said personal information is saved as said history information. (Page 26, line 11 through Page 27, line 31)

Claim 11: Durst discloses an information collection system according to claim 6, characterized in that the time information obtained when said portable terminal has accessed is saved as said history information. (Page 19, line 22 through Page 20, line 31)

Claim 12: Durst discloses an information collection system according to claim 6, characterized in that the day of week or day of month information obtained when said portable terminal has accessed is saved as said history information. (Page 19, line 22 through Page 20, line 31)

Claim 16: Durst discloses an information collection system according to claim 9, characterized in that the transmission count of the pointer of said pointer sending means affixed to each of a plurality of advertisements that constitute a group, or transmission count per said group obtained by totaling said transmission count is saved as the transmission count of said pointer. (Page 26, line 11 through Page 27, line 31)

Claim 29: Durst discloses an Information collection system according to claim 1, characterized in that said portable terminal transfers said pointer obtained from said pointer sending means to a television set, and that said television set uses said pointer to acquire information from an information provider via a network. (Page 4, line 22 through Page 5, line 24)

Claim 43: Durst discloses an article where a non-contact IC card is affixed that records a pointer specifying the information acquisition destination of the information acquired from a network. (Page 5, line 25 through Page 6, line 7)

Claim 44: Durst discloses a printed advertisement according to claim 43, characterized in that a pointer specifying an advertisement server is recorded on said non-contact IC card. (Page 13, line 28 through Page 14, line 30)

Claim 45: Durst discloses a printed advertisement according to claim 43, characterized in that a pointer specifying the seller or reservation desk of an advertised article is recorded on said non-contact IC card. (Page 13, line 28 through Page 14, line 30)

Claim 46: Durst discloses a printed advertisement according to claim 43, characterized in that a pointer specifying the information provider of story information carried in a magazine of the advertised article is recorded on said non-contact IC card. (Page 13, line 28 through Page 14, line 30)

Claim 47: Durst discloses a magazine according to claim 43, characterized in that a pointer specifying the information provider of the carried story information is recorded on said non-contact IC card. (Page 13, line 28 through Page 14, line 30)

Claim 48: Durst discloses a magazine according to claim 43, characterized in that a pointer specifying the advertisement server for the carried advertisement is recorded on said non-contact IC card. (Page 13, line 28 through Page 14, line 30)

Claim 49: Durst discloses a product according to claim 43, characterized in that a pointer specifying a service center and the model are recorded on said non-contact IC card. (Page 13, line 28 through Page 14, line 30)

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Thad Eugene Starner ("Wearable Computing and Contextual Awareness" Ph.D. Thesis, MIT 1999) which discloses RFID tags used to identify objects to a user as they move about a room. Also discloses is the inclusion of advertising based upon the users contextual space.
- b. David Arnold et al. ("Discourse with Disposable Computers: How and Why You Will Talk to Your Tomatoes", pp. 9-21 in *Proceedings of the Workshop on Embedded Systems (ES99)*, USENIX, Cambridge, Massachusetts, USA, March 1999), which discloses an interactive environment where IC cards are included in numerous articles.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*gms*

jvb

December 29, 2005



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